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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/612,166	07/08/2000	Holger Kunstle	U-Wp-5528 Wacker	8687

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EXAMINER

AFTERGUT, JEFF H

ART UNIT

PAPER NUMBER

1733

DATE MAILED: 06/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/612,166

Applicant(s)

KUNSTLE ET AL.

Examiner

Jeff H. Aftergut

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

***Claim Rejections - 35 USC § 103***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1-8, 11-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent 47-3705 in view of EP 295727 for the same reasons as expressed in paper 15, paragraph 5.

With regard to newly added claims 17 and 18, the applicant is advised that the reference to EP '727 suggested that those skilled in the art at the time the invention was made would have incorporated 0.2-3% by weight of acrylic acid as a stabilizer (see page 2, lines 38-43).

3. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as set forth above in paragraph 2 further taken with Japanese Patent 4-145182 for the same reasons as expressed in paper no. 15, paragraph 6.

With regard to claim 19, the reference to Japanese Patent '182 suggested that the adhesive composition was useful as flooring adhesive. As was common in the art of flooring, the tile or vinyl was attached to a slab which was concrete (wherein the concrete would have been understood to have been a cementitious, alkaline surface. The such is taken as conventional in the art of flooring. It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the adhesive of the references as set forth above as a floor adhesive wherein the flooring was a cementitious surface (which is alkaline).

4. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as set forth above in paragraph 3 further taken with the applicant's admitted prior art.

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With respect to claim 19, the reference to Japanese Patent '182 suggested that the adhesive composition would have been useful for flooring. The reference did not express that the underfloor was a concrete or cement compound which was alkaline. It was known at the time the invention was made as admitted by applicant that flooring was conventionally a cementitious surface which was naturally alkaline. It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the processing as set forth above in paragraph 3 to apply flooring to the known and conventional cementitious alkaline floors as such were common as admitted by applicant in the admitted prior art.

***Response to Arguments***

5. Applicant's arguments filed 5-9-03 have been fully considered but they are not persuasive.

The applicant first requests a complete translation of the Japanese documents. Such will be forthcoming as soon as they are available, however the rejection based upon the abstract and the formula of the Japanese Patent '705 is herein maintained. Applicant argues that EP '727 taught that one would have utilized VeoVa9 rather than VeoVa10 and that VeoVa9 has a glass transition temperature of greater than 0 degrees C. More properly, however, EP '727 expressly suggested that the formula and disclosure in Japanese '705 incorporated a VeoVa10 in the blend of polymers, see page 2, lines 25-35 of the reference which expressly referred to Japanese Patent 7293705 and stated that the reference employed VeoVa10. More significantly, while VeoVa9 had a glass transition temperature higher than 0 degrees C, the reference to Japanese Patent '705 only suggested VeoVa9 in one embodiment (where R1, R2 and R3 have 3 carbon atoms therein) and suggested a complete range of C in the mixture from 9-33. VeoVa10 and VeoVa11 have

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glass transition temperature of less than 0 degrees C and one would have expected that additional carbon would have further reduced the glass transition temperature (i.e. 12-33 carbon atoms would have a further reduction in glass transition temperature). Applicant's argument that one would have only selected VeoVa9 from the possible list of 9-33 is unreasonable, as the direction given by the reference would have suggested a larger amount of carbon atoms in the finished polymer. Additionally, EP '727 expressly suggested that one skilled in the art would have incorporated an acrylic acid (component (d) of the claims herein) in the copolymer as a stabilizer to the copolymer and that the acrylic acid would have been added in an amount from .2-3% by weight. The applicant is advised that while applicant may have had a different reason for adding the acrylic acid in the blend of polymers such does not negate the fact that one skilled in the art at the time the invention was made would have been led to incorporate the same in the blend for the reasons proposed by EP '727 (see In re Lintner, 173 USPQ 360, In re Shetty, 195 USPQ 753, In re Hoch, 166 USPQ 406 and In re Wilder, 166 USPQ 545). Clearly, there was motivation to incorporate the acrylic acid in the blend of polymers to make the adhesive and such would have been directed to do the same in order to stabilize the polymer.

It should be noted that while a complete translation of Japanese Patent '705 is not available, one skilled in the art would have expected that some kind of stabilizer would have been expected to have been used with the composition and upon a complete translation it is expected that the reference would have hinted at or suggested the same. Because there certainly was a direction to utilize VeoVa10 in the composition of Japanese Patent '705 (as expressly suggested by EP '727), it is believed that the claimed composition was suggested by the combination. The applicant is advised that the same composition would have had the same glass

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transition temperature and that while Japanese Patent '705 does not explicitly recite the same the ordinary artisan would have expected that such a glass transition temperature would have been present.

The applicant argues that the references do not exclude alkyl acrylates, however the applicant is advised that if the same were present in the compositions then the references would have expressed their inclusion therein. The fact that the references did not suggest the use of the same is suggestion enough that the alkyl acrylates are not present.

The applicant is advised that the reference to EP '727 suggested the use of the composition as an adhesive composition and additionally that Japanese Patent '705 was referred to as a paint composition which was "too tacky" (clearly tackiness would have been desired for an adhesive). Additionally, the reference to Japanese Patent '182 suggested that those skilled in the art at the time the invention was made would have incorporated similar adhesive compounds as flooring adhesives (which is what applicant has chosen to use his adhesive for). Clearly then, one skilled in the art viewing the prior art as a whole would have been motivated to utilize the compound of Japanese Patent '705 as modified by EP '727 to incorporate a stabilizer therein as a flooring adhesive as such was suggested in the prior art to Japanese Patent '182. the applicant argues Japanese Patent '182 in a vacuum of the other references and states that the reference does not cure the deficiencies of Japanese Patent '705, however as addressed above no such deficiencies exist. The only teaching relied upon from Japanese Patent '182 is that one would have known to utilize adhesives of a similar composition and/or nature to that of Japanese Patent '705 as a flooring adhesive. This is not disputed by applicant and therefore it is believed that one

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would have been led to utilize the adhesives of Japanese Patent '705 as modified by EP '727 for a flooring adhesive which was a tacky adhesive material.

***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

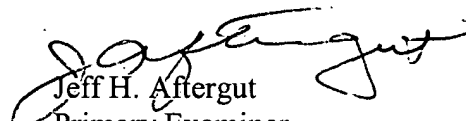
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff H. Aftergut whose telephone number is 703-308-2069. The examiner can normally be reached on Monday-Friday 6:30-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael W. Ball can be reached on 703-308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

  
Jeff H. Aftergut  
Primary Examiner  
Art Unit 1733

JHA  
June 5, 2003